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Joel Voeltzke
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Anahit Tataryan et al.

Examiner: Nasser Ahmad

Serial No. 10/523,866

Group Art Unit 1772

Filed: February 7, 2005

Docket No. 110-015.US

(formerly Avery-70396)

For: SEND-REPLY LABEL

APPLICANTS' REPLY TO EXAMINER'S ANSWER

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is Applicants' Reply to the Examiner's Answer dated August 24, 2007 in the above-identified application.

I. INTRODUCTION

Applicants and the Examiner have now both filed appeal briefs stating their respective positions. Applicants continue to believe that all of their arguments presented in their Appeal Brief are valid, and that all of the claims on appeal should be allowed. Applicants file this Reply Brief only in order to address certain specific arguments urged by the Examiner.

II. METHOD CLAIMS 30 AND 31 ARE CLEARLY NOT ANTICIPATED

A. MPEP §2112.01(III) IS INAPPLICABLE

It is important to note that while the Examiner has rejected the *product* claims on the ground that the Examiner opines that the printed matter recited is not functionally related to the product (Examiner's Answer at p. 6, citing MPEP §2112.01(III)), that basis for a rejection can only apply to the *product claims* (See *Id.*, entitled "*Product Claims – Nonfunctional Printed Matter Does Not Distinguish Claimed Product from Otherwise Identical Prior Art Product*") (emphasis added). The Examiner's stated reasoning based on MPEP §2112.01(III) does not apply to claims 30 and 31 because claims 30 and 31 are *method claims*.

Specifically, claim 30 recites the *method steps* of:

printing mailing information on said inner label; and
removing said send label and adhering [it] to a first object to be mailed to provide said mailing information thereon.

The citation to MPEP §2112.01(III) and the Examiner's reliance thereon is wholly inapplicable to claim 30 and its dependent claim 31.

B. NEITHER OF THE REFERENCES RELIED UPON HAS ANYTHING TO DO WITH MAILING

More importantly, neither of the cited references relied upon has anything to do with mailing. Consequently, neither of those references remotely suggests the recited method steps of

printing mailing information on a particularly constructed label, *adhering the label to an object to be mailed*, and then *mailing* that object with that label on it an address label, as recited in claim 30. The Examiner has rejected claim 30 as anticipated by both Aoyagi and Stipek, but neither of those has anything to do with mailing.

Claim 31 further recites the method steps of:

mailing said first object;
removing said inner label of said send label from said first object; and
adhering said inner label to a second object to be mailed to provide said mailing information thereon.

Again, these method steps are not remotely suggested by the references, which have nothing to do with mailing and therefore cannot anticipate the claimed method.

The Examiner's statement that, "[R]egarding claim 30 and 31 . . . Aoyagi or Stipek anticipate[] the claimed *structure* . . . including *the printed information* thereon" (Examiner's Answer at p. 7) (emphasis added) is both misdirected and deceptive. The statement is misdirected because claims 30 and 31 are directed to claimed *methods*, not to a "claimed structure" as argued by the Examiner. The statement is deceptive because Aoyagi and Stipek certainly each teach printing *something*, but they fail to teach "the printed information" that is recited in the claims, specifically printing *mailing information*.

II. PRODUCT CLAIMS 1 AND 13 DO SHOW A FUNCTIONAL RELATIONSHIP BETWEEN THE PRINTED MATTER AND THE SUBSTRATE

With respect to product claims 1 and 13 the Examiner contends that the printed matter recited in the claims does not bear a functional relationship to the product, and that therefore "the content of the printed matter does not distinguish the claimed product from prior art of Aoyagi." (Examiner's Answer at p. 6)

Applicants respectfully disagree. The recited element of "mailing information" printed on labels so that those labels can function as mailing labels, clearly defines a functional relationship between the printed information (the mailing information) and the function which the structure thereby performs (a send-reply label function). The printing gives the structure a novel and nonobvious function (a combined send-reply label function) which the structure otherwise would not have. Accordingly, the content of the printed matter, and the new and nonobvious function which the printed matter allows the structure to perform, must be taken into considered in evaluating patentability. Because neither of the references relied upon disclose or suggest the printing of mailing information on the otherwise recited structure, or indeed have anything to do with mailing, the product claims patentably distinguish over the cited references.

Respectfully submitted,

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